

Remarks/Arguments

Claims stand subject to restriction under 35 USC 121 for allegedly lacking unity of invention in accordance with PCT Rule 13.1. Pursuant to the restriction requirement, election is made, hereby, to prosecute invention Group VIII, claim 14 in part, with traverse.

Traverse is maintained because the record does not support the finding of lack of unity of invention, under PCT Rule 13.1, among invention groups VIII-XIII. Pursuant to Administrative Instructions Under the PCT, Annex B (Unity of Invention), Part 1(b) (emphasis added):

Instructions Concerning Unity of Invention . . .

(b) **Technical Relationship.** Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

The restriction fails to apply the correct definition of "special technical features."

According to the restriction requirement (Office Action, page 5) (emphasis added):

the inventions listed as Groups . . . V-XIII do not relate to a single general inventive concept under PCT Rule 13.1, because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons . . . the common technical feature in all groups [is] the minor vault protein ADPRTL1. However, this common technical feature cannot be a special technical feature under PCT Rule 13.2 because the feature is shown in the prior art . . . *Genomics*. 62(3): 533-6, 1999 [Still].

The reliance on Still is misplaced, because the restriction fails to apply the proper standard for determining whether the claims in invention Groups VIII-XIII share one or more "special technical

features" in accordance with "PCT Rule 13.2."

In accordance with Administration Under The PCT (shown above), under PCT Rule 13.2 "special technical features" of the claims "considered as a whole" is determined based "on the contents of the claims as interpreted in light of the description." Thus, "considered as a whole . . . the contents of the claims as interpreted in light of the description" show that the claims have a common technical feature that defines a "contribution . . . over the prior art"; the common special technical feature being use of the minor vault protein ADPRTL1 in a method involving diagnosis or treatment of neurodegenerative diseases—not merely the minor vault protein ADPRTL1, itself, as alleged in the statement of restriction.

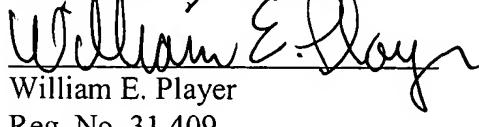
Accordingly, the claims of invention Groups VIII-XIII do relate to a single general inventive concept under PCT Rule 13.1 because, under PCT 13.2, they share the same or corresponding special technical feature, for the foregoing reasons. Withdrawal of the restriction among invention Groups VIII-XIII, claims 14-20, appears to be in order.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:


William E. Player
Reg. No. 31,409

400 Seventh Street, N.W.
Washington, D.C. 20004-2201
Tel.: 202-638-6666
Fax: 202-393-5350
Date: November 15, 2006
WEP/jhr

R:\rthomas\wep\2006\November\P67785US1 resp. to restric. req.wpd